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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/902,321	07/10/2001	Michael Lee Vatter	8160	8449

27748 7590 01/24/2002

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EXAMINER

BERMAN, ALYSIA

ART UNIT	PAPER NUMBER
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1619

DATE MAILED: 01/24/2002

8

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/902,321

Applicant(s)

VATTER ET AL.

Examiner

Alysia Berman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 September 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____.

DETAILED ACTION

Specification

1. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.
2. The disclosure is objected to because of the following informalities: the specification refers to a US patent at page 6, line 14 but an incorrect number is given.

Appropriate correction is required.

3. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
5. Claims 3, 9, 11 and 14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
6. Claim 3 recites a Markush group but is not written in proper Markush form. The proper language for a Markush group is, for example, "selected from the group consisting of A, B **and** C" or "wherein A is B **or** C." Substitution of "or" with "and" in line 2 would overcome this rejection.

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7. Claim 9 is indefinite because it appears to contain typographical errors at line 7, contains information in parentheses and is in improper Markush form. It appears that a comma may be missing between aluminum starch octenyl succinate and barium silicate. It is unclear if the information in parentheses is a required limitation of the claim. The claim recites the word "and" in line 13 and line 15. It is unclear what Applicant intends encompass within the Markush group. Does Applicant intend that the Markush group encompass all of the components of the claim or that the Markush group encompasses only the components up to carboxyvinyl polymer at lines 13-14?
8. Claim 11 is indefinite because it recites "hydantoin derivatives" at lines 3-4. It is unclear what Applicant intends by derivatives. The metes and bounds of the claims cannot be determined.
9. Claim 14 is indefinite because it appears to be missing essential elements. The last line of the claim recites, "wherein contain at least about 1% air." What contains at least about 1% air?
10. Claim 14 is indefinite because it recites percents of components but does not provide units of measurement or to what the percents are in relation.

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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12. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

13. Claims 1-10 and 12-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tachibana et al. (US 5,412,004 A).

Tachibana is directed to the manufacture of paste-like silicone compositions that can be used in water-in-oil cosmetic emulsions (title and abstract). Applicant discloses at page at page 5, lines 4-11 and page 6, lines 12-14 that the emulsifying crosslinked siloxane elastomers are those disclosed by Tachibana. The water-in-oil cosmetic emulsion of Tachibana may contain various components in the discontinuous water phase such as saccharides, sugar alcohols, inorganic salts, polyoxyalkylene-modified organopolysiloxane emulsifiers (surfactants) and cosmetic powders (col. 3, line 55 to col. 4, line 18).

For solids such as organically modified montmorillonite clay, see column 8, lines 38-47. For sorbitol, a polyhydric alcohol of claim 4, see column 9, lines 28-29. For dimethicone copolyol emulsifier, see column 9, line 38 to column 10, line 53. For additional solids and fillers, see column 10, line 57 to column 11, line 6. For

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preservatives and skin conditioning agents such as moisturizers, which encompasses emollients, see column 11, lines 53-57. See examples 15+ for preservatives and forms of the compositions such as foundation, eye shadow and rouge (blusher).

Tachibana discloses at column 7, lines 33-39 that the paste-like composition comprises 100 parts by weight of the silicone polymer (emulsifying siloxane elastomer) and 10-1000 parts by weight of a silicon oil. This is equivalent to 9-90.0 wt.% of each of the components, which overlaps the instantly claimed percent ranges of claim 14.

Tachibana does not disclose the droplet size distribution range of the discontinuous phase, the average particle size of the emulsifying crosslinked siloxane elastomer or the amount of air contained in the composition. It is within the skill in the art to select optimal parameters in a composition in order to achieve a beneficial effect. *In re Boesch*, 205 USPQ 215 (CCPA 198). Therefore, absent evidence of unexpected results, it is considered within the skill in the art to select optimal droplet size and particle size in the compositions of Tachibana for aesthetic purposes. Applicants admit at page 20, lines 8-13 that the compositions may be aerated by hand or mechanical mixing as well as any conventional form of foaming or whipping. It is the Examiner's position that simple stirring would incorporate an amount of air of at least 1% in the compositions. Therefore, the compositions of Tachibana necessarily contain at least about 1% air as instantly claimed. Burden is shifted to Applicant to show that the compositions of Tachibana do not contain the instantly claimed amount of air.

It would have been obvious to one of ordinary skill in the art at the time of the invention to select an optimal droplet size of the discontinuous phase and particle size

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of the emulsifying siloxane elastomer in the compositions of Tachibana expecting to obtain stable cosmetic water-in-oil emulsions that provide good feeling upon use.

14. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tachibana et al. as applied to claims 1-10 and 12-14 above, and further in view of Hawley, G. G., The Condensed Chemical Dictionary, 10th Ed., Van Nostrand Reinhold Co., New York (1981) pages 121, 385, 434 and 686.

Tachibana teaches all the limitations of the claims as stated in the 35 U.S.C. 103(a) rejection above. It does not teach the preservatives of instant claim 11. Tachibana does teach that the compositions contain preservatives. The preservatives of instant claim 11 are conventional substances used in the cosmetic art. According to Hawley, disodium EDTA, phenoxyethanol and methylparaben are all known preservatives. Benzyl alcohol is also known for use in cosmetics.

It would have been obvious to one of ordinary skill in the art at the time of the invention to add any one of the preservatives above to the composition of Tachibana for their known antimicrobial effects.

Double Patenting

15. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

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Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

16. Claims 1-14 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 3-17 of copending Application No. 09/850,845. Although the conflicting claims are not identical, they are not patentably distinct from each other because both applications are claiming compositions comprising a crosslinked siloxane elastomer and a solvent. The term comprising permits additional ingredients.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

17. Claims 1-13 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-21 of copending Application No. 09/850763. Although the conflicting claims are not identical, they are not patentably distinct from each other because both applications are claiming composition comprising a crosslinked siloxane elastomer and a solvent. The term comprising permits additional components.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

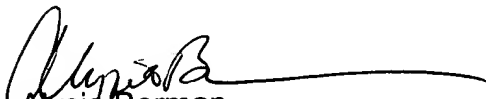
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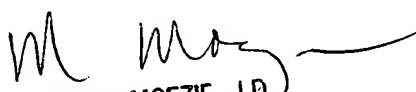
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alysia Berman whose telephone number is 703-308-4638. The examiner can normally be reached during core hours.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Minna Moezie, can be reached on 703-308-4612. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306 or 703-872-9307 for after-final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1234 or 703-308-1235.


Alysia Berman
Patent Examiner
January 15, 2002


MINNA MOEZIE, J.D.
SUPERVISORY PATENT EXAMINER
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1/15/02